

REMARKS

Claims 1-30 are pending in the application. Of the pending claims, claims 1-19, 21-23, and 26-30 are rejected. Examiner deems claim 20 allowable if rewritten to include the limitations of the base claim. Claims 24 and 25 are allowed. Applicants respectfully request reconsideration of these rejections.

Claim Amendments

Claims 1 and 28 have been amended. No new matter has been added.

Claim Rejections – Drawings

The Examiner has objected to the drawings because claim 29 claims “a non-divisible skin” and the drawings show the flexible skin (10) being sewn together from a plurality of sections. The Examiner asserts that two sections of material that are sewn together are divisible. (Office Action (“OA”) at page 2.) Applicants disagree. Once two pieces of material are sewn together, they are no longer divisible in the common, ordinary sense. The only way to divide them is to damage them by cutting the fabric or cutting the stitching. For example, a pair of pants is typically sewn together from a plurality of sections. Yet, no one would think that the pair of pants is divisible. On the other hand, if the pants are put together with Velcro, or snaps or zippers, they could be considered divisible. In this case, the flexible skin can be sewn together but that is not required. (Spec at ¶52.) But, in either event, the flexible skin is not “divisible” in the plain ordinary meaning of the word divisible. Applicants request Examiner to reconsider this rejection.

Claim Objections

The Examiner objects to claims 1, 7, 8, 15, 16, 26-30 because she claims the term “non-removably connected” is unclear with respect to direction. (OA at page 2.) A review of the complete phrase in question, however, shows that it is sufficiently clear to a person of ordinary skill in the art. The complete phrase at issue is “non-removably connected to the two ends of the first flexible framing rods.” (Claims 1, 7, 8, 15, 16, 26-30.) A plain reading

of the phrase specifies that only the two ends of rods are “non-removably connected” to the skin.

The specification breathes life into the meaning of the term. Paragraph 50 defines “non-removably connected” as “a connection that is not intended to be disconnected at any time by the user under ordinary circumstances during the useful life of the tent, including when the tent is set up, taken down, or stored away for future use.” In addition, Paragraph 50 states that a “non-removable” connection could be removable in a non-ordinary circumstance, such as to remove and replace a broken part.”

Likewise, paragraph 5 equates “non-removably connected” with the word “fixed.” (Spec. at ¶5 (“The flexible skin is also fixed (or non-removably connected) to the ends of the flexible framing rods.”) Similarly, paragraph 44 states that FIG. 10 “illustrates an embodiment of the non-removable connection between the flexible framing rod and flap.” In addition to FIG. 10, paragraph 55 describes an embodiment of a non-removable connection. Specifically, the “flared section 17 on one side of the grommet 14 and the flexible ring 18 on the other side keeps the grommet 14 non-removably connected to the end 22. (Spec. at ¶ 55.)

For these reasons, the term “non-removably connected to the two ends of the first flexible framing rods” is sufficiently clear to a person of ordinary skill in the art. Applicants request Examiner to reconsider this rejection.

Applicants’ have amended claim 28 as Examiner suggests.

Claim Rejections – 35 U.S.C. §102

The Examiner Failed To Show That Applicants’ Claims Are Anticipated

For a claim to be rejected under this statute, it must be anticipated by the prior art. Anticipation occurs when every element of the claimed invention is found in a single prior art reference.¹ In addition to including every element of the claimed invention, the prior art

¹ *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987); see also, *Electro Med. Sys. v. Cooper Life Sciences*, 34 F.3d 1048 (Fed. Cir. 1994) (stating, “[a]nticipation under 35 U.S.C. §102 (b) requires the

reference must also “be enabling and describe the applicants’ claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.”² In other words, for the prior art reference to anticipate the claimed invention, all of the elements in the claim must be found in a single piece of prior art “in exactly the same situation and united the same way to perform the identical function. . . .”³

A. Applicants’ Claims 1-16 and 28-30 are not anticipated by U.S. Pat. No. 7,025,073 issued to Holub (“Holub”).

1. Holub is not prior art.

The present application is a National Stage Entry of PCT/US04/43986 filed on December 30, 2004. PCT/US04/43986 claims priority to US provisional application 60/534,308. (Spec at ¶1.) The filing date of the provisional application was January 5, 2004. The filing date of Holub was February 17, 2004 – after Applicants’ priority date. Thus, Holub is not prior art.

2. Claims 1-16, 28-30

In the event that Examiner maintains her assertion that Holub is prior art, Applicants maintain all of the responses previously asserted in the response filed September 8, 2009.

In addition, on page 15 of the present OA, Examiner states that Applicants’ claims read on prior art having a plurality of little rods joined together to become one big rod because Applicant has not included a phrase like “unitary” or “single piece of rod.” That would be true except that Applicant’s claims also include the limitation that **both** ends of Applicants first and second framing rods are non-removably connected to the flexible skin (see, e.g., claim 1.) None of the little-rods-joined-together art cited by examiner satisfies that

presence in a single prior art disclosure of each and every element of a claimed invention. . . .”); *General Elec. Co. v. Hoechst Celanese Corp.*, 740 F.Supp. 305, 313 (Del. 1990) (stating that “[i]n order to anticipate a later claim, a single prior source must contain all of the essential limitations of the claim”).

² *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994).

³ *Sandisk Corp. v. Lexar Media, Inc.*, 91 F.Supp.2d 1327, 1336 (N.D. Cal. 2000). See also, *In re Arkeley*, 455 F.2d 586, 587 (P.App.Cir. 1972) (stating that “rejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the ‘prior art’”) (emphasis in original).

limitation (see, e.g. Holub and Howe). Thus, if Examiner maintains her rejections based on cited art that teaches a plurality of little rods joined together to form a big rod, Examiner must demonstrate how **both ends** of each little rod are non-removably connected to the flexible skin. For the reasons, Holub does not anticipate the claims 1-16, 28-30 even if it could be considered prior art.

B. Applicants' Claims 17 and 21 are not anticipated by Lindamood (US 6,772,883)

In claim 17, Applicant's claim included the following limitation

“...and a first pocket, wherein the first pocket is connected to the back sheet inside face near the back sheet perimeter ..., wherein the first pocket is oriented to receive the ends of the flexible rods..”

Examiner asserts that Applicants' “at least one pocket” is disclosed in Lindamood as element 34. (OA at 6.) Element 34 from Lindamood, however, is not a pocket. Element 34 is an “equipment transport belt.” (5:8; 6:43.) In addition to not being “a pocket”, Lindamood's element 34 does not “oriented to receive ends of the flexible rods while the flexible framing rods are stored inside of the storage bag” as required by claim 17.

Claim Rejections – 35 U.S.C. §103(a)

Applicants' Claims Are Not Rendered Obvious Under 35 U.S.C. §103 Over Any Of The Prior Art Patents

The Examiner has rejected Applicants' claims 1-5, 7-8, 10-16, and 28-30 under 35 U.S.C. §103. Applicants respectfully disagree with the Examiner.

The Examiner has failed to establish a prima facie case of obviousness. When examining a patent application, the Examiner has the initial burden of factually supporting a prima facie conclusion of obviousness.⁴ Additionally, when rejecting claims under 35 U.S.C. §103, it is incumbent upon the Examiner to establish a factual basis to support the legal

⁴ See, *In re Otiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

conclusion of obviousness.⁵ In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Specifically, the Examiner must (1) determine the scope and content of the prior art; (2) determine the differences between the prior art and the claims at issue; and (3) determine the level of ordinary skill in the art.⁶ In addition to these factual determinations, the Examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”⁷ Moreover, the analysis supporting obviousness should be made explicit and should “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements” in the manner claimed.⁸

Only if the Examiner makes a *prima facie* case of obviousness, does the burden shift to the Applicants for providing evidence of non-obviousness.⁹ Obviousness is then determined based on the evidence as a whole and the persuasiveness of the arguments.¹⁰ Here, the Applicants respectfully assert that the Examiner has failed to meet the evidentiary burden.

Additionally, the cited prior art differs from the Applicants’ claims. Therefore, a person of ordinary skill in the art at the time of the invention would not have looked to the prior art cited by the Examiner to create Applicants’ claims. As such, the Applicants respectfully request that the Examiner reconsider Applicants’ claims.

C. Applicants’ Claims 1-5, 7-8, 10-16, and 28-30 are not obvious over Howe (U.S. Pat. No. 5197504) in view of Wu (U.S. Pat. No. 5,370,145).

1. Claims 1-5, 7-8, 10-16

Claims are not obvious if the principal operation of the cited art must be changed. MPEP § 2143.01. (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the

⁵ See, *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988).

⁶ See, *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

⁷ See, *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

⁸ See, *KSR Int’l Co. v. Teleflex*, No. 04-1350, slip op. at 15 (U.S. 4-30-2007).

⁹ See, *In re Otiker*, 977 F.2d at 1445.

¹⁰ See, *Id.*

teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352).

Here, Claims 1-5, 7-8, 10-16 all depend from claim 1. Thus, if claim 1 is allowable, Claims 1-5, 7-8, 10-16 will be allowable. As amended herein, Claim 1 includes the following limitations:

- a. ...a first flexible framing rod...
- b. ...a second flexible framing rod...
- c. ... a flexible skin ... non-removably connected to the two ends of the first flexible framing rod, and non-removably connected to the two ends of second flexible framing rod...

Neither Howe nor Wu disclose a flexible skin being non-removably connected to **each end** of a flexible framing rod as Applicants disclose and claim. Specifically, Howe teaches that one end of one of his plurality of little rods can remain connected to the skin in order to store the tent. **All** other framing other ends do not remain non-removably connected. Most significantly, Howe teaches detaching one end of the rod from the flexible skin. (Howe, 3:25-67; "during disassembly and storage of the tent, the other ends 3, 5, and 7 are each detached from membrane 2 for storage.")

Likewise, neither Howe nor Wu disclose "flexible framing rods" where **both ends** of each rod are connected to the skin. Specifically, Howe teaches jointed poles that can be folded up for storage. (Howe 4:49-58.) By inspection, the ends of Howe's rod's do not

remain connected to the flexible skin because the rods are disconnected from each other and folded up.

These differences between the claims and the cited art are significant because the proposed modification or combination of the prior art would change the principle of operation of the prior art invention. The only way Howe teaches storage is to remove one end of the rod from the flexible skin and fold up the rods. Applicants teach a way to leave the rods connected at their ends to the flexible skin and still be able to store the structure in a storage back. Therefore, the extensive modifications of Howe in order to achieve the solution provided here are so great that Howe in view of Wu cannot be said to render Applicants' claims 1-16 obvious.

2. Claims 28

Claim 28 includes the following limitations:

- a. ...a first flexible framing rod...
- b. ...a second flexible framing rod...
- c. ... a flexible skin ... non-removably connected to the two ends of the first flexible framing rod, and non-removably **connected to the two ends** of second flexible framing rod,
- d. wherein **when the fast-erecting tent is released from the storage device, the fast-erecting tent springs into shape.**

As discussed in the previous section, neither Howe nor Wu disclose a flexible skin being non-removably connected to each end of the flexible framing rods as Applicants disclose and claim. Specifically, Howe teaches that one end of his rods are designed to be removed from the skin in order to store the tent. (Howe, 3:25-67; “during disassembly and storage of the tent, the other ends 3, 5, and 7 are each detached from membrane 2 for storage.”)

Likewise, neither Howe nor Wu disclose “flexible framing rods” that are connected at each end to the flexible skin. Specifically, Howe teaches jointed poles that can be folded up for storage. (Howe 4:49-58.) Howe’s rod is made up of lots of little rods. But the end of

each little rod cannot be said to be non-removably connected to the flexible skin as disclosed and claimed by Applicant.

Further, neither Howe nor Wu teach a tent that springs into shape after being released from the storage bag.

These differences between the claims and the cited art are significant because the proposed modification or combination of the prior art would change the principle of operation of the prior art invention. The only way Howe teaches storage is to remove one end of the rod and fold up the rods. Applicants teach a way to leave the rods connected at their ends to the flexible skin and still be able to store the structure in a storage bag. Further, by keeping the ends of the flexible rods connected to the flexible skin, Applicants' solution can spring into shape upon release from the bag – the cited art cannot achieve this. Therefore, Howe in view of Wu cannot be said to render Applicants' claims 1-16 obvious.

3. Claims 29-20

Claims 29 and include the following limitations:

- a. ...a first flexible framing rod...
- b. ...a second flexible framing rod...
- c. ... a flexible skin ... non-removably connected to the two ends of the first flexible framing rod, and non-removably **connected to the two ends** of second flexible framing rod,
- d. and wherein the **two ends of the first flexible framing rod and the two ends of the second flexible framing rod act as a base of the fast-erecting portable structure**

As discussed in the previous section, neither Howe nor Wu disclose a flexible skin being non-removably connected to each end of the flexible framing rods as Applicants disclose and claim. Specifically, Howe teaches that one end of his rods are designed to be removed from the skin in order to store the tent. (Howe, 3:25-67; “during disassembly and storage of the tent, the other ends 3, 5, and 7 are each detached from membrane 2 for storage.”)

Likewise, neither Howe nor Wu disclose “flexible framing rods” that are connected at each end to the flexible skin. Specifically, Howe teaches jointed poles that can be folded up for storage. (Howe 4:49-58.) Howe’s rod may be made up of lots of little rods. But the **end of each little rod cannot be said to be non-removably connected** to the flexible skin as disclosed and claimed by Applicant.

Further, neither Howe nor Wu teach a tent wherein **each end** of the rod non-removably connected to the flexible skin to form a base as disclosed and claimed by Applicant.

These differences between the claims and the cited art are significant because the proposed modification or combination of the prior art would change the principle of operation of the prior art invention. The only way Howe teaches storage is to remove one end of the rod and fold up the rods. Applicants teach a way to leave the rods connected at their ends to the flexible skin and still be able to store the structure in a storage bag. Therefore, Howe in view of Wu cannot be said to render Applicants’ claims 1-16 obvious.

D. Applicants’ Claims 26 and 27 are not obvious over Howe (U.S. Pat. No. 5197504) in view of Wu (U.S. Pat. No. 5,370,145) and Ransom et al. (U.S. Pat. No. 7,040,333).

Applicants’ incorporate all the previous reasons their claims are not obvious in light of Howe and Wu. If they are not obvious in light of Howe and Wu, the addition of Ransom does not make them obvious.

In addition, claims 26 and 27 include a first pocket; Ransom does not. The purpose of the first pocket is to receive one end of the framing rods so that the rods can be coiled in the bag. This difference between the claims and the cited art are significant because the proposed modification or combination of the prior art would change the principle of operation of the prior art invention. Ransom doesn’t disclose or teach a pocket because it does not store a tent having flexible framing rods non-removably connected at the ends to the flexible skin. Ransom teaches a bag without a first pocket because Ransom houses a

tent with continuous frame members that do not have ends. (Ransom, 3:32-40.) In order to need a first pocket, Ransom's tent would need to undergo significant redesign.

E. Applicants' Claims 17-19 and 21-23 are not obvious over Camara (U.S. Pat. No. 5,937,883) in view of Rosen et al. (U.S. Pat. No. 6,382,376).

Claims 17-19 and 21-23 all depend from claim 17. Thus, if claim 17 is allowable, Claims 17-19 and 21-23 will be allowable. As amended herein, Claim 1 includes the following limitations:

- a. A storage bag for storing a fast-erecting portable structure having flexible rods...
- b. a first pocket, wherein the first pocket is connected to the back sheet inside face near the back sheet perimeter and ... wherein the first pocket is oriented to receive the ends of the flexible rods.

Camara cannot be cited as disclosing "flexible framing rods." Camara discloses rigid, two-piece poles that are designed to be hammered into the ground as stakes. (Camara, 3:65-4:11.) Camara could not have flexible framing rods without undergoing substantial redesign.

In addition, Camara's pockets 28 are not for receiving the ends of the flexible framing rods and disclosed and claimed by Applicant. **Camara's pockets 28 are for storing "food, personal effects or accessories..."** (Camara 3:44-46.) Nowhere has Examiner cited (or can Applicants find) that Camara discloses "a first pocket, wherein the first pocket is connected to the back sheet inside face near the back sheet perimeter and ... wherein the first pocket is oriented to receive the ends of the flexible rods." Since Camara would have to be redesigned to have a first pocket for receiving flexible framing rods, Camara does not render Applicants' claims obvious.

F. Applicants' Claims 17-19 and 21-23 are not obvious over Bell, III (US 7,111,714) in view of Kiose (US 4,182,391).

Claims 17-19 and 21-23 all depend from claim 17. Thus, if claim 17 is allowable, Claims 17-19 and 21-23 will be allowable. As amended herein, Claim 1 includes the following limitations:

- a. A storage bag for storing a fast-erecting portable structure having flexible rods...
- b. a first pocket, wherein the first pocket is connected to the back sheet inside face near the back sheet perimeter and ... wherein the first pocket is oriented to receive the ends of the flexible rods.

Neither Bell or KJose can be cited as disclosing "a fast-erecting portable structure having flexible rods flexible framing rods." Examiner has not cited anywhere in either patent where this can be found. Just because cited art may have a pocket on the inside, Examiner cannot say that this is a pocket oriented to receive flexible framing rods. Nowhere has Examiner cited (or can Applicants find) that Bell or KJose discloses "a first pocket, wherein the first pocket is connected to the back sheet inside face near the back sheet perimeter and ... wherein the first pocket is oriented to receive the ends of the flexible rods."

Conclusion

Applicants believe they have addressed and responded to every point raised in the Examiner's present action. For the reasons stated above, Applicants respectfully request reconsideration of this application.

Respectfully submitted,

Date: July 16, 2010

/Joseph R. Meaney /
Joseph R. Meaney, Reg. No. 45,276
Venable, Campillo, Logan & Meaney, P.C.
Attorneys for Applicant
1938 E. Osborn Road
Phoenix, Arizona 85016
(602) 631-9100